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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,147	01/24/2002	Steven B. Daum	1814-0003	2356

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EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,147

Applicant(s)

DAUM, STEVEN B.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-23 are pending in this case.

2. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

3. Examiner's Opinion:

Para 2 above applies. The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The concept of data processing via computers, processors linked via a network is generic.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1- 6 and 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6 and 15-16 are rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection

Art Unit: 2121

is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35 U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, '376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**"). See, MPEP 21107.01 (IV), quoting In re Kirk (emphasis added).

7. Therefore, claims 1-6 and 15-16 are rejected on this basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Yagesh et al (U. S. Pub. 2003/0171939, referred to as **Yagesh**).

Claim 1

Yagesh anticipates obtaining voluntary consent from a first passenger to perform a background check on the first passenger (**Yagesh**, p 0173; Examiner's Note (EN): voluntary consent is provided upon making of reservation); b) formulating a data record associated with the first passenger if the passenger passes the background check (**Yagesh**, p 0173; Fig. 6); c) obtaining biologically oriented identification data associated with the first passenger (**Yagesh**, Fig. 6; EN: photo, sex, nationality, etc.); (d) storing the biologically oriented identification data in the data record (**Yagesh**, Fig. 6; EN: PTIDN repository); e) prior to the passenger aircraft flight, obtaining biological oriented measurement data from a person purporting to be the first passenger (**Yagesh**, p 0208; EN: individual questioning will secure biological oriented data, i.e. visual identification, voice stress, etc.); f) comparing the biologically oriented measurement data to the biologically oriented identification data (**Yagesh**, p 0209); g) selectively permitting the person to participate in the passenger aircraft flight based on the comparison (**Yagesh**, p 0209; EN: selectively determined based on intelligence data).

Claim 2

Yagesh anticipates step b) further comprises formulating a data record associated with the first passenger if and only if the passenger passes the background check (**Yagesh**, p 0181; EN: passing means to be of interest).

Claim 3

Yagesh anticipates storing, positive screening results data in the data record if and only if the passenger passes the background check (**Yagesh**, p 0181; EN: passing means to be of interest).

Claims 4, 14, 21, 22

Yagesh anticipates step e) further comprises associating the person with a first fractional aircraft owner (**Yagesh**, p 0181, 0116).

Claim 5

Yagesh anticipates c) further comprises scanning a portion of the person to gather the biological oriented measurement data (**Yagesh**, p 0209; EN: a picture represents a scan to gather biological oriented measurement data).

Claim 6

Yagesh anticipates the passenger aircraft flight is one of a set of regular repeating scheduled flights (**Yagesh**, p 0177).

Claim 7

Yagesh anticipates a) a memory (**Yagesh**, Claim 8); b) a communication device (**Yagesh**, Claim 9); c) a processing circuit (**Yagesh**, Claim 8) operable to: formulate and store in the memory a data record associate with a first passenger, the data record including an indication that the first passenger has passed a background check, the data record further including biologically oriented identification data associated with the first passenger(**Yagesh**, Claim 8; p 0209); receive biological oriented measurement data associated with a person (**Yagesh**, p 0209); compare the biologically oriented

measurement data to the biologically oriented identification data in the data record (Yagesh, Claim 8; p 0208, 0209); and provide an indication signal to the communication device, the communication signal operable to cause the communication device to provide a human perceivable indicia representative of the result of the comparison (Yagesh, Claim 9).

Claim 8

Yagesh anticipates the processing circuit includes more than one processor (Yagesh, Claim 8).

Claim 9

Yagesh anticipates the processing circuit includes more than one processor connected via network (Yagesh, Claim 8; p 0015).

Claims 10, 19, 20

Yagesh anticipates the more that one processors are connected via the Internet (Yagesh, p 0015).

Claims 11, 13

Yagesh anticipates the communication device includes a visible display (Yagesh, p 0015; EN: computers have visible displays called monitors).

Claim 12

Yagesh anticipates the communication device includes an audible sound generator (Yagesh, p 0015; EN: computers have visible displays called monitors with sound generators as standard equipment).

Art Unit: 2121

Claim 15

Yagesh anticipates obtaining voluntary consent from a first passenger to perform a background check on the first passenger (**Yagesh**, p 0173; Examiner's Note (EN): voluntary consent is provided upon making of reservation); b) formulating a data record associated with the first passenger if the passenger passes the background check (**Yagesh**, p 0173; Fig. 6); c) scheduling the passenger aircraft flight as one of a plurality of regular scheduled flights (**Yagesh**, p 0184); (d) prior to the passenger aircraft flight, determining whether a person is associated with a formulated data record (**Yagesh**, Claim 8); e) denying participation by the person in the passenger aircraft flight if the person is not associated with a formulated data record (**Yagesh**, claim 8).

Claim 16

Yagesh anticipates wherein step d) includes: gathering biologically oriented measurement data from the person (**Yagesh**, p 0209); comparing the biologically oriented measurement data to biologically oriented identification data previously stored within the data record (**Yagesh**, p 0208; 0209).

Claim 17

Yagesh anticipates a) a memory (**Yagesh**, Claim 8); b) a first processing circuit (**Yagesh**, Claim 8) operable to: formulate and store in the memory a data record associate with a each of a plurality of passenger, each data record including an indication that the associated passenger has passed a background check (**Yagesh**, Claim 8; EN: incorporated into shared data bases); c) a second processing circuit operable to receive a signal from an input circuit indicative of an identification of a

person, the person attempting to participate in an aircraft flight (**Yagesh**, Claim 8); determining whether the signal correlates to one of the plurality the data records (**Yagesh**, Claim 8); and provide an indication signal to the communication device, the communication signal operable to cause the communication device to provide a human perceivable indicia representative of the result of the comparison (**Yagesh**, Claim 9).

Claim 18

Yagesh anticipates the first processing circuit and the second processing circuit constitute a single processing device (**Yagesh**, 0015; EN: computers are multiple processing devices).

Claim 23

Yagesh anticipates indication is the existence of the data record (**Yagesh**, Claim 8).

Conclusion

10. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Alberte, U.S. Patent 6,692,696
- Hoffberg et al, U.S. Patent 6,400,996
- Broadhurst, U.S. Patent 5,278,418

11. Claims 1-23 are rejected.

Correspondence Information

12. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II

2121 Crystal Drive,

Arlington, Virginia.

Joseph P. Hirl

April 14, 2004